

REMARKS

Upon entry of the present amendment, Claims 5-7 will be amended. Claims 5-7 remain pending in the present application. Claim 5 is the sole independent claim. Applicant requests reconsideration and allowance in view of the foregoing amendments and the following remarks.

Entry of this Amendment is proper under 37 C.F.R. § 1.116 because the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issues that would require further consideration and/or search as the amendments and arguments presented merely amplify issues previously discussed throughout prosecution; and (c) place the application in better form for an appeal, should an appeal be necessary. The amendments are necessary and were not earlier presented as they are in response to new grounds of rejection entered in the Final Rejection. Applicant respectfully requests entry of the Amendment.

1. Claims 5-7 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. In particular, the Office Action noted that the preamble of Claims 5-7 claims a method while the body of the claims claim system element "means." The Office Action also noted that in Claim 6, the "addressee" in the phrase "means for saving said lottery number and said addressee to a file" causes confusion, and the phrases "such as" and "sending mail server settings within said terminal device are rewritten with the mail server of said server device" are

unclear. The Office Action also noted that in Claim 7, the phrase "making accessing" causes confusion.

Applicant has amended Claims 5-7 to fully comply with 35 U.S.C. § 112, second paragraph, and respectfully requests reconsideration and withdrawal of the rejections of Claims 5-7 under 35 U.S.C. § 112, second paragraph.

2. Claims 5 and 7 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Sugimoto Hideo et al. (Japan Patent Application Publication No. JP 11-242714). Claim 6 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Sugimoto Hideo et al. Applicant respectfully traverses these rejections.

Applicant respectfully submits that the claimed invention and the invention described by Sugimoto Hideo et al. are completely different in their fundamental concepts. For example, the claimed system relates to a typical e-mail system including a single sender and a single receiver, whereas the Sugimoto Hideo et al. system relates to a single transmitting person (e.g., a sender) sending an e-mail greeting card to many addressees (e.g., receivers). Therefore, the construction of each detailed step is quite different. Claim 5 is distinguished from Sugimoto Hideo et al. for at least five reasons.

First, Sugimoto Hideo et al. fails to teach element (c) of Claim 5, which recites "means for determining the suitability of the e-mail upon completion of creating the e-mail." The web page 800 shown in Fig. 11 of Sugimoto Hideo et al. gives instructions on entering an identifier and e-mail address of the sender in 804, and e-mail addresses of many recipients in 806. There is

a notice that senders cannot send mail to themselves, but no checking system or means are shown. In contrast, element (c) of Claim 5 of the present invention checks to determine whether an e-mail address is invalid, and only valid e-mail addresses receive an e-mail with a lottery number and a home page address attached (see steps S2A03 and S2A04 of Fig. 2, and the paragraph beginning on line 6 of page 5 of the specification). As described in paragraph 39 of Sugimoto Hideo et al., only a possible premium (e.g., a gift) from 802 and an identity and address of a sender from 804 in Fig. 11 is sent to the receivers in the system of Sugimoto Hideo et al. The possible premium or gift is selected by the sender. Receivers can check to see if they won the gift after winners of the gift are randomly selected, but receivers do not receive a lottery number (see paragraph 0045 of Sugimoto Hideo et al.).

Second, as to element (d) in Claim 5, the recited determining means of element (c) "determines whether the e-mail address is valid," then in element (d) a lottery number, an address of the homepage, and a notification of a drawing is sent to the recipient (see steps S2A07 and S2A08 of Fig. 2, and the paragraph beginning on line 15 of page 5 of the specification). In the system of Sugimoto Hideo et al., only a notice regarding an e-mail with a greeting card and a possible premium (e.g., gift) is sent to each receiver (see paragraph 0028 of Sugimoto Hideo et al.).

Third, as to element (e) in Claim 5, the lottery number and the e-mail address of recipients are saved in the server (see steps S2A07 and S2A08 of Fig. 2, and the paragraph beginning on line 15 of page 5 of the specification). In the system of Sugimoto Hideo et al., the

sender, receiver and other selected items are saved in server database 127 of server system 104 (see Fig. 1 and paragraph 0031 of Sugimoto Hideo et al.).

Fourth, as to element (f) in Claim 5, the server randomly determines a winning lottery number from the saved lottery numbers (see steps S2C01-S2C03 of Fig. 2, and the paragraph beginning on line 2 of page 6 of the specification). In contrast, as shown in Fig. 14, the server 104 searches the database 127 of the system of Sugimoto Hideo et al. to randomly determine winners of premiums (e.g., gifts) based on the participant who transmitted or received the greeting card (see Fig. 14 and paragraphs 0050 and 0051 of Sugimoto Hideo et al.).

Fifth, as to element (e) in Claim 5, the system also has means for checking the identification of a winner (see steps S2B01-S2B06 of Fig. 2, and the paragraph beginning on line 13 of page 6 of the specification). The system of Sugimoto Hideo et al. contains no idea of using typical e-mail communications for a lottery system. The system of Sugimoto et al. is confined to greeting cards (see paragraphs 0008-0013 of Sugimoto Hideo et al.).

Applicant respectfully submits that Claims 5-7 are allowable and respectfully requests reconsideration and withdrawal of the rejection of Claims 5 and 7 under 35 U.S.C. § 102(b) as being anticipated by Sugimoto Hideo et al., and the rejection of Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Sugimoto Hideo et al.

3. Applicant respectfully submits that the proposed amendments made herein properly respond to the outstanding Final Rejection and represent a *bona fide* effort to satisfactorily conclude the prosecution of this application. Care has been exercised to insure that no new

matter has been introduced and that no new issues have been raised that would require further consideration or search. It is felt that no inordinate amount of time will be required on the part of the Examiner to review and consider this amendment. In the event that the application is not allowed, it is requested that this amendment be entered for purposes of appeal.

4. For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

September 29, 2005

Respectfully submitted,

By 
Michael A. Sartori, Ph.D.
Registration No.: 41,289
Thomas C. Schoeffler
Registration No.: 43,385
VENABLE LLP
P.O. Box 34385
Washington, DC 20043-9998
Attorney/Agent for Applicant

MAS/TCS

#158674 v1 - Amendment and response to 07/08/2005 final office action